

### **REMARKS**

Claims 1-5, 20, 21, 24 and 26-32 are pending in the application. Claims 1, 5, 26 and 30 have been amended. Prior claims "26-32" following pending claim 26 have been re-numbered as "27-32," respectively to correct a prior claim numbering error.

Claims 1 and 26 have been amended for clarity and to distinguish the present invention, particularly that the upper panel has a planar surface. Support for the amendments to claims 1 and 26 may be found in the specification, at least, at paragraph [0028]. Claims 5 and 30 have been amended to explain the nature of the raised projections. Support for the amendments to claims 5 and 30 may be found in the specification, at least, at paragraph [0028]. Applicants acknowledge the Examiner's withdrawal from consideration of non-elected species for the purpose of examination with the expectation that upon allowance of the elected species, the remaining species would also be allowed.

### **Claim Rejections Under § 112**

The Examiner has rejected claims 5 and 26-32 based on 35 U.S.C. § 112 as failing to comply with the written description requirement. The Examiner asserts claims 5 and 30 are not supported by the specification regarding "uniform" height of the second projections.

In regard to claims 5 and 30, Applicants have amended the claims to remove "uniform." Accordingly, this rejection should be withdrawn.

The Examiner asserts claim 26 is not supported by the specification. Specifically, the Examiner states that no support exists for applying adhesive to the peripheral lip of the first lower panel and the peripheral lip of the second upper panel.

Applicants submit that the Examiner has acknowledged that the specification supports "adhesive is applied to the peripheral lip of the first lower panel." Office Action page 3. While not agreeing with the Examiner's view of the scope of the disclosure, Applicants have amended the claims to simplify the language such that this rejection is now moot.

The Examiner has rejected claims 1-5, 20-21, 24 and 26-32 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, the Examiner is unclear as the meaning of the phrase "wherein each projection defines a coplanar surface".

Applicants have amended claims 1 and 26 as requested by the Examiner to define that the upper surfaces of the projections are surfaces that are each coplanar to one another (meaning lie in the same plane).

The Examiner has commented as to the necessity for the phrase “the peripheral lips remain in substantial proximity to form the composite panel” when the claim recited that the peripheral lips of the first panel and the second panel are joined. The Applicants draw the Examiner’s attention to the Figures that show that the panels may be joined via an adhesive bead. The panels may be very close together but not exactly touching or may be touching so that the claims reflect that the panels’ peripheral lips can, but need not be in full facing engagement depending upon the nature and thickness of the adhesive used.

Applicants respectfully submit that the claims as amended comply with 35 U.S.C. § 112 and the above rejections should be withdrawn.

**Claim Rejection Under § 102(b) Based on Rashid**

The Examiner has rejected claims 1-2, 5 and 24 under § 102(b) as unpatentable over U.S. Patent No. 5,536,060 of Rashid et al. (“Rashid”). The Examiner has alleged that Rashid teaches a method of manufacture wherein all of the elements of the claimed invention are recited. Page 4 of the Official Action dated March 15, 2007. Applicants respectfully traverse the rejection.

Applicants have amended claim 1, from which claims 2, 5 and 24 directly depend, to further define the invention and the relationship of the individual features of the panel. Specifically, the Applicants have amended claim 1 to define that the upper surfaces of the plurality of projections are coplanar as requested by the Examiner. Further, Applicants have deleted the term “substantially” in these claims based on the Examiner’s comments and to eliminate any confusion.

Recognizing that the upper surfaces of the projections are coplanar, it should be recognized these coplanar surfaces are parallel, “planar” in nature and each have planes that lie in the same plane (*i.e.*, are coplanar). In the claimed invention, the upper panel is planar and the upper surfaces of the projections of the lower panel are coplanar, to ensure contact of the raised projections from the lower section and for structural integrity. Further, this is necessary to allow

for adhesive connection of the peripheral lip of the lower panel with the peripheral lip of the upper panel as discussed in paragraph [0029] of the specification.

In view of the amendments to claims 1, the Rashid configuration would not be acceptable in the claimed invention because the outer panel (12) is contoured and the reinforcement panel (14) conforms to the shape of the outer panel (12). Rashid, column 4, lines 17-21. This is in contrast to the coplanar surfaces of the raised projections of the claimed invention and planar upper panel. As the remaining claims depend from claim 1, this argument also applies and the dependent claims would not be anticipated.

In order to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim element is contained in a single prior art reference. *See* M.P.E.P. § 2131 (August 2004). Rashid does not meet this requirement. Specifically, Rashid does not disclose that the upper surfaces of the plurality of projections are coplanar (incorporating the language as suggested by the Examiner) or a planar upper panel.

Appreciating these differences, Rashid does not expressly or inherently recite all of the limitation of the rejected claims. Therefore, Applicants respectfully submit that the rejection of claims 1-2, 5 and 24 as anticipated by Rashid is improper and should be withdrawn.

#### **Claim Rejection Under § 102(b) Based on Fujimoto**

The Examiner has rejected claims 1-2, and 24 under § 102(b) as unpatentable over U.S. Publication No. 2004/0021342 “Fujimoto (“Fujimoto”). The Examiner has alleged that Fujimoto teaches a method of manufacture wherein all of the elements of the claimed invention are recited. Page 5 of the Official Action dated March 15, 2007. Applicants respectfully traverse this rejection.

Applicants submit that the car hood of Fujimoto is not planar as claimed in claim 1, but is “formed in a gentle arc.” Fujimoto, paragraph [0117]. Applicants respectfully submit that the Examiner does not appreciate the description of the hood structure as disclosed in paragraph [0117] and [0118] as appreciated when read in its entirety, specifically, with respect to the term “flat top 3” on line 3 of paragraph [0117]. Applicants submit “flat top 3” does not mean the surface (4) is parallel to the top of the corrugated bead (5a) but that its meaning is in regard to a flat or smooth bendable surface. Appreciating the comments throughout the Fujimoto

specification, specifically in paragraphs [0050], [0117] and claim 2, the hood structure has an inner structure cross-sectional shape in a sine curve for head impact resistance. Thus, Fujimoto does not teach that the projections each have surfaces which are coplanar surface, i.e., lie in the same plane, nor does it have an “upper panel having a planar surface” as in amended claim 1 of the present invention.

Appreciating these differences, Fujimoto does not expressly or inherently recite all of the limitation of the rejected claims. Therefore, Applicants respectfully submit that the rejection of claims 1-2, and 24 as anticipated by Fujimoto is improper and should be withdrawn.

**Claim Rejection Under § 102(e) Based on Myers**

The Examiner has rejected claims 1-2, 4, 20-21, 24, 26-27, 29 and 31-32 under § 102(e) as unpatentable over U.S. Patent No. 6,857,683 of Myers (“Myers”). The Examiner has alleged that Myers teaches a method of manufacture wherein all of the elements of the claimed invention are recited. Page 6 of the Official Action dated March 15, 2007. Applicants respectfully traverse this rejection.

Myers is a truck bed cover which discloses a plurality of “quadrant” supports. Column 4, lines 1-10. This “key feature” is critical to Myers as it is based on the desired structural strength and rigidity. Column 4, lines 47 -67 and column 5, lines 1-2. In contrast, the claimed invention is a composite panel formed of two separate pieces having raised projections extending from the lower panel and adhered to the lower surface of the planar upper panel.

Applicants respectfully submit that the Examiner has misstated the structure of the truck cover in Myers. Specifically, the Examiner on page 6 of the Office Action erroneously refers to a “plurality of raised projections 32” when “32” represents the “recessed portion” of the support structure 30”. Myers at column 3, lines 58-64. Applicants submit the Examiner is defining the recessed portion 32 as equivalent to the raised projections of the claimed invention. However, in review of the structure of Myers, and specifically Figs 3 and 4, the Examiner’s interpretation of the recessed portion in Myers is not proper because 1) the support members, e.g. support member 34 in Fig. 3 and 4, are not between the top cover 28 and support structure 30, thus allowing the joining of these surfaces, and 2) the overall structure in Myers requires the support members to be exposed, unlike the present invention. In Myers, the surfaces of the support members 34, 36,

etc., face away from the top cover 28. Myers, see Figs. 3 and 4 and column 3, lines 58-64. Thus, in contrast to Myers, the present invention has a plurality of projections each having an upper surface which is coplanar with the other projection upper surfaces and which contacts the upper panel via a planar surface, as claimed.

Appreciating these differences, Myers does not expressly or inherently recite all of the elements of the rejected claims. Therefore, Applicants respectfully submit that the rejection of claims 1-2, 4, 20-21, 24, 26-27, 29 and 31-32 as anticipated by Meyers is improper and should be withdrawn.

**Claim Rejection Under §103(a) Based on Fujimoto in view of Corder**

The Examiner has rejected claims 20-21 under 35 U.S.C. § 103(a) as being unpatentable over Fujimoto in view of U.S. Patent No. 6,568,495 of Corder et al. ("Corder"). As discussed herein, the Examiner takes the position that Fujimoto teaches all of the elements of the composite panel of the claimed invention. The Examiner further believes that the combination of Fujimoto with Corder, which teaches use of a reinforced panel for use as a tonneau cover, renders the claimed invention obvious. Applicants respectfully traverse the rejection.

A rejection based on obviousness should be made with a complete understanding of 1) a determination of the scope and content of the cited art, 2) appreciation of the differences between the prior art and claimed invention, 3) the level of ordinary skill in the pertinent art and 4) consideration of objective evidence pertaining to the invention (also called "secondary considerations") which include, but are not limited to: commercial success, unexpected results, the failure of others and whether there is a long felt need in the art which the invention fulfills. See Graham v. John Deere, 383 U.S. 1, 17 (1966).

Applicants submit that based on the discussion herein regarding Fujimoto and the amendments to claim 1, all of the elements of the present invention are not recited. The addition of Corder does not cure this deficiency, e.g., all of the elements of the present invention not being recited in the combination of references, and therefore, a rejection based on obviousness cannot be supported.

Further, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine Fujimoto with Corder to provide the particular configurations of

claims 20 and 21 in order to successfully make the invention of those claims because the basic structure, e.g. the weight and materials, would be different based on the objective of Corder and Fujimoto. In regard to Corder, this reference focuses on systems to automatically move a generally horizontal and closed panel to an upwardly angled open position. See all Figures 1-21. The claims in Corder involve various automated lifting mechanisms for below beltline applications. Further, Corder does not describe any particular composite panel or any reason/direction of a why a composite panel would be of a specified design.

Applicants agree with the Examiner that the Corder reference does discuss the use of the invention described in Corder as a "trunk or deck lid, or a convertible roof tonneau cover." Column 1, lines 46 through 52. However, the invention in Corder (and the invention in Fujimoto) would need to be substantially modified so as to obtain the claimed invention. No motivation or direction exists to make these modifications as both Fujimoto and Corder have objectives that do not exist in the present invention. Specifically, Fujimoto is based on a desire for strength and collision integrity and Corder is an automatic system that would impart unwanted characteristics to the presently claimed invention which are not necessary.

Applicants submit that the combination of Fujimoto and Corder would not teach all of the elements of the claimed invention as amended. Adding Corder to Fujimoto does not address the elements that are not in Fujimoto, as discussed herein. Specifically, neither Fujimoto nor Corder teaches a composite panel having a planar top panel adhered to a series of coplanar raised projections and adhered along the periphery of the panels for use as a tonneau cover. Further, no motivation exists to combine or modify the references to obtain the present invention.

Appreciating these differences, Applicants respectfully submit that the Examiner has not established a *prima facie* case for obviousness and the rejection of claims 20 and 21 is improper and should be withdrawn.

**Claim Rejection under 35 U.S.C. § 103(a) as being unpatentable over Fujimoto in view of Corder and further in view of Rashid et al. and/or Myers**

The Examiner has rejected claims 26-27 and 31-32 under 35 U.S.C. § 103(a) as being unpatentable over Fujimoto in view of Corder as applied to claims 1 and 20-21 above and further in view of Rashid et al. and/or Myers. The Examiner takes the position that it would have been

obvious to apply adhesive to the peripheral lips of the panel of Fujimoto because such is known in the composite panel art as taught by Rashid and Myers.

Applicants submit that based on the discussion herein in regard to Fujimoto, Rashid and Myers and the amendments to claims, all of the elements of the present invention are not recited. The addition of Corder does not cure this deficiency, e.g., all of the elements of the present invention not being recited in the combination of references, as discussed herein and therefore, an obviousness rejection based on this combination of references is not supported.

Applicants submit that the Examiner has given no reason as to why one skilled in the art would look to add adhesive to the “peripheral lip” in Fujimoto. Specifically, the resin layer (7) of Fujimoto has functions, including, sound-muffling, shock absorbing and the like which would be ineffective at the contact or hem (4b). As the resin (7) in Fujimoto is based on completely different design and functional requirements, no motivation exists to combine Fujimoto with Myers or Rashid in applying adhesive to the peripheral lip.

Appreciating these differences, Applicants respectfully submit that the Examiner has not established a *prima facie* case for obviousness and the rejection of claim 26, 27 and 31, 32 is improper and should be withdrawn.

**Claim Rejection Under §103(a) Based on Greve et al in view of Rashid et al. and/or Fujimoto and/or Myers.**

The Examiner has rejected claims 1-2 and 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,273,606 of Greve et al. (“Greve”) in view of Rashid and or Fujimoto and/or Myers. As discussed herein, the Examiner takes the position that Rashid, Fujimoto and Myers teach all of the elements of the composite panel of the claimed invention. The Examiner now takes the position the combination of Greve in view of Rashid and/or Fujimoto and/or Myers renders the claimed invention obvious. Applicants respectfully traverse the rejection.

The Examiner believes that Greve teaches a method of manufacturing a composite panel to be used in a variety of vehicle parts by forming a lower panel with a peripheral lip having raised projections, forming an upper panel having a substantially planar surface and a peripheral lip, wherein the peripheral lips of the lower panel and upper panel fit snugly to form a composite

panel. The Examiner states in the Office Action that it is unclear as to whether Greve teaches the projections are coplanar and that the coplanar surfaces are adhered to the upper panel but relies on Rashid, Fujimoto and Myers for these elements.

Applicants have addressed each of the references, Rashid, Fujimoto and Myers and have distinguished each from the present invention, particularly based on the differences in the structure of the lower panel 30 and the projections 32, which extend therefrom, and the coplanar upper surfaces 34 which contact the upper panel 44, the upper panel 44 being planar as in amended claim 1. The addition of Greve does not cure the deficiencies of these references as discussed herein and stated by the Examiner. All of the limitations of the present invention are not within the combination of references and therefore the rejection is improper.

In addition, no motivation exists to combine Greve with Rashid, and/or Fujimoto and/or Myers based on the structure and objectives in these references. Specifically, Rashid and Fujimoto have a specific peripheral "attachment" design based on their structure (as discussed herein) and Myers would not have any need for the "hem" design in Greve.

Appreciating these differences, Applicants respectfully submit that the Examiner has not established a *prima facie* case for obviousness and the rejection of claims 1, 2 and 24 is improper and should be withdrawn.

**Claim Rejection under 35 U.S.C. § 103(a) as being unpatentable over Greve in view of Rashid and or Fujimoto and/or Myers as applied to claim 1 above, and further in view of Corder**

The Examiner has rejected claims 20-21, 26-27 and 31-32 under 35 U.S.C. § 103(a) as being unpatentable over Greve in view of Rashid and or Fujimoto and/or Myers as applied to claim 1 above, and further in view of Corder.

Applicants have addressed the reference combination of Greve in view of Rashid and or Fujimoto and/or Myers previously and the Rashid, Fujimoto and Myers references individually to distinguish the differences of the present invention. The inclusion of Corder does not cure the deficiency in obtaining all of the limitations of the present invention. Therefore, the combination of references does not include all of the limitations of the tonneau cover of the present invention as in claims 20 and 21.



In regard to claim 26, Applicants have previously addressed the application of the adhesive with respect to the combination of references. As to claims 27 and 31-32, Applicants have previously addressed the substantive content of these claims based on the claims from which they depend.

Appreciating these differences, Applicants respectfully submit that the Examiner has not established a *prima facie* case for obviousness in regard to claims 20-21, 26-27 and 31-32 and the rejection is improper and should be withdrawn.

**Claim Rejection Under §103(a) Based on Seksaria in view of Fujimoto and/or Myers and/or Greve**

The Examiner has rejected claims 1-3, 5 and 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,124,191 of Seksaria (“Seksaria”) in view of Fujimoto and/or Myers and/or Greve. The Examiner has taken the position that Seksaria teaches a method of manufacture of a panel that can be used in a vehicle by forming a lower layer with projections forming a coplanar surface and adhering it to an upper layer. The Examiner recognizes that Seksaria does not teach a peripheral lip. Applicants respectfully traverse the rejection.

Seksaria teaches an aluminum/plastic composite for use wherever it is desired to have at least one exposed smooth metallic finish surface. Column 1, lines 24-26. Seksaria teaches cup segments which are irregular in shape and size, in contrast to the use of shapes, to provide coplanar surfaces as in the claimed invention. This is significant as it relates to the strength and structural differences that exist in Seksaria and the claimed invention. Specifically, Seksaria teaches a configuration that is not uniform but which is individually designed to depend on the strength in certain areas to accommodate randomly spaced components over which the structural panel is to be located. Column 1, lines 60-65. Thus, the cup-shaped components would be of a different depth as needed based on “under-hood components”. Column 2, lines 23-26. Moreover, it is recognized in Seksaria “the outer aluminum sheet 12 configuration is not formed in a single plane.” Column 3, lines 46-47. Therefore, the outer aluminum sheet 12 and the sheet molding compound component 14 are not planar, in contrast with the upper panel and lower panel of the present invention. Appreciating that the outer aluminum sheet 12 and the sheet molding compound component 14 are not planar, there is no teaching regarding any peripheral

lip or joining of peripheral lips, e.g. a peripheral lip lower panel which “fits snugly” within the peripheral lip of the upper panel of the present invention. It should be recognized that a peripheral lip of the design of the present invention could not exist in Seksaria based on the variation of sizes and non-planar surfaces.

Applicants respectfully submit that no motivation exists to combine Seksaria with Greve, and/or Fujimoto and/or Myers to obtain the claimed invention. Specifically, each of the secondary references has a peripheral lip configuration based on the design objective and use of each individual reference. The lack of any peripheral lip design in Seksaria is evidence it is not of relevance to the panel design in the other references. Therefore, combining Seksaria, which the Examiner believes has similar features to the present invention, with other references or list of references which may have other features which the Examiner believes are similar to the claimed invention, is improper and based on hindsight reasoning and not any motivation or teaching within the references. Further Seksaria’s design, which cannot accommodate peripheral lips teaches away from the secondary reference designs.

Appreciating these differences, Applicants respectfully submit that the Examiner has not established a *prima facie* case for obviousness and the rejection of claims 1-3, 5 and 24 is improper and should be withdrawn.

**Claim Rejection Under §103(a) Based on Seksaria, in view of Fujimoto and/or Greve and/or Myers in view of The Blankenburg Patents**

The Examiner has rejected claims 3-4 under 35 U.S.C. § 103(a) as being unpatentable over Seksaria in view of Fujimoto and/or Greve in view of U.S. Patent No. 4,906,508 of Blankenberg et al. (“B-508”) and U.S. Patent No. 5,242,735 of Blankenberg et al. (“B-735”) (collectively, “the Blankenberg patents”). The Examiner has taken the position that B-508 and B-735 teach the configurations of the projections which could be used with the other designs. Applicants respectfully traverse the rejection.

Applicants respectfully submit that it is appreciated that various configurations can be used as structural support no matter what material is being used, i.e. paper, plastic, metal etc. However, the specific application where it may be used requires unique engineering and creative design, i.e. invention, to develop a functional system. The addition of the knowledge that these

configurations exist adds no motivation to combine the cited references to obtain the claimed invention nor does it cure the absence of the claimed limitations missing from Seksaria, Fujimoto and/or Greve and/or Myers as discussed herein. Specifically, the references are missing the combined teaching of a planar upper panel and raised projections, which are coplanar as claimed.

Appreciating these differences, Applicants respectfully submit that the Examiner has not established a *prima facie* case for obviousness and the rejection of claims 3 and 4 is improper and should be withdrawn.

**Claim Rejection Under §103(a) Based on Seksaria, in view of Fujimoto and/or Greve in view of Corder**

The Examiner has rejected claims 20-21, 26-28 and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over Seksaria in view of Fujimoto and/or Myers and/or Greve and further in view of Corder. Applicants respectfully traverse the rejection.

Applicants have previously addressed the combination of Seksaria, Fujimoto and/or Greve and/or Myers herein. The addition of the Corder reference which mentions a possible use of the particular body panel therein as a “trunk or deck lid” does not overcome the issues regarding modification of the references to obtain the claimed invention as discussed herein, and the absence of teaching all of the limitations of the claimed invention.

Appreciating these differences, Applicants respectfully submit that the Examiner has not established a *prima facie* case for obviousness and the rejection of claims 20-21, 26-28 and 30-32 is improper and should be withdrawn.

**Claim Rejection Under §103(a) Based on Seksaria, in view of Fujimoto and/or Myers and/or Greve in view of Corder and the Blankenburg patents**

The Examiner has rejected claims 28-29 under 35 U.S.C. § 103(a) as being unpatentable over Seksaria in view of Fujimoto and/or Myers and/or Greve in view of Corder as applied to claim 26, and further in view of Blankenburg B-508 and B-735. Applicants respectfully traverse the rejection.

Applicants have previously addressed the combination of Seksaria, Fujimoto and/or Greve and/or Myers herein. The addition of the Corder reference which mentions a possible use of the particular body panel therein as a “trunk or deck lid” does not overcome the issues regarding modification of the references to obtain the claimed invention, as discussed herein, and

the absence of teaching all of the limitations of the claimed invention. Further, as discussed above in regard to the Blankenburg patents, Applicants respectfully submit that it is appreciated that various configurations can be used as structural support no matter what material is being used, i.e. paper, plastic, metal etc. However, the specific application where it may be used requires unique engineering and creative design, i.e. invention, to develop a functional system. The addition of the knowledge that these configurations exist adds no motivation to combine the cited references to obtain the claimed invention.

Appreciating these differences, Applicants respectfully submit that the Examiner has not established a *prima facie* case for obviousness and the rejection of claims 28 and 29 is improper and should be withdrawn.

#### **Secondary Considerations**

Finally, with regard to all of the above § 103 rejections, Applicants submit that even if *prima facie* obviousness had been shown, which Applicants maintain it has not, Applicants' composite panels provide a long-felt need in the art for lightweight composite panels that are sufficiently strong and provide an upper planar surface and smooth exterior appearance on the sides of the panel for use in exterior and other surfaces of a vehicle, which are subject to exterior conditions and/or significant wear such as a vehicle floorboards, tonneau covers, door and roof panels. Therefore, Applicants respectfully submit that any such *prima facie* obviousness, is overcome by the uniqueness of the Applicants' invention and the long-felt need in the art, and withdrawal of the rejections are respectfully requested.

In view of the foregoing, Applicants submit that claims 1-5, 20, 21, 24 and 26-32 are patentable over cited references. Reconsideration and withdrawal of all rejections, and a Notice of Allowance are respectfully solicited.

Respectfully submitted,

**JOHN C. MONTAGNA ET AL.**

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(Date)

By:

**JOSEPH J. DIDONATO**

Registration No. 48,897

**FLASTER/GREENBERG P.C.**

8 Penn Center

1628 John F. Kennedy Blvd., 15<sup>th</sup> Floor

Telephone: 215.279.9393

**Direct Dial: 215.279.9376**

Facsimile: 856.661.1919

E-Mail: joseph.didonato@flastergreenberg.com